

REMARKS

An Office Action was mailed in the above-captioned application on March 14, 2006. Claims 1-5, 7-10, 15 and 78-96 are pending. All of the pending claims stand rejected. The forgoing amendment and the following remarks are submitted in response to the Office Action of March 14, 2006.

This matter was the subject of an interview with examiner Marjorie A. Moran on Wednesday, May 24, 2006. Attorney for applicant, Barry J. Swanson thanks the examiner for her input during said interview. No specific agreements were reached during the interview. The Martin reference was discussed in detail as described below, and the pending claims were discussed during the interview.

OBJECTION TO CLAIM 97 PURSUANT TO 37 CFR 1.75.

Claim 97 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. Claim 97 has been amended to specifically recite the free standing rod-shaped particle as an electronic device or a part of an electronic device. This additional limitation serves to distinguish the scope of claim 97 from claim 1.

CLAIM REJECTIONS – 35 USC § 112, FIRST PARAGRAPH

Claims 1-5, 7-10 and 88-96 stand rejected pursuant to 35 USC § 112, First Paragraph, as failing to comply with the written description requirement. The examiner argues that the particle, as it was previously claimed containing “informational content on the composition of the particle” is new matter. Claims 1 and 88 are independent claims. The balance of the claims rejected pursuant to § 112 depend from claims 1 or 88.

Claim 1 has been amended to replace the limitation, “wherein the particle contains informational content based on the composition of the particle” with the following: “Wherein the particle contains information regarding an associated material.” Claim 88 is amended in an identical fashion.

The amendment to claims 1 and 88 does not change the scope of these claims. The amendment does however accomplish two purposes. First, the foregoing amendment more clearly describes the nature of applicant's claimed particle. Second the foregoing amendment effectively addresses the examiner's new matter concerns. In particular, support for claim 1 and claim 88 may be found throughout the specification, for example:

When used as tag or label the particles of the present invention can be associated in any way with the material it is labeling. The particular tag can be selected and identified so that it provides information regarding the material it is associated with. For example a tag within a paint may encode the date of manufacture, the chemicals used in the paint mix, the name of the manufacturer, photodynamic characteristics of the paint or any number of other pieces of information. (pg. 20 ln. 29 – pg. 22 ln. 3)

The particles of the present invention may be used for a variety of applications. There are two major classifications of uses: those embodiments where the segments of the particle have informational content, and those where the segments do not have informational content. In those embodiments where the segments have informational content, the best analogy is to macroscopic bar coding. Conventional bar coding provides for a strip of black lines whereby the distance between lines and thickness of the lines are used to "code" a significant amount of information. Because of the small size of the particle of the present invention, in certain embodiments it is possible to use the particles of the invention as molecular tags. Unique identifying tags that can be "read" can be attached to any material including to molecular entities in order to track molecular events. (pg. 15 lns. 9-18)

CLAIM REJECTS – 35 USC §112, SECOND PARAGRAPH

Claims 88-98 stand rejected under 35 USC § 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular the examiner contends that claim 88 does not clearly recite one of a method or a product-by-process type claim. With respect to claims 97 and 98, the scope of the “electronic device” limitation on the claimed particles is argued to be unclear.

In response to the § 112, second paragraph rejections applicant has amended claims 88 and 97. Claim 88 has been amended to unambiguously claim a particle made by a process.

Claim 97 has been amended to positively recite the limitation that, “wherein the particle is an electronic device or a part of an electronic device.” Applicant notes that the, “in which a particle can function” language which is attributed to claim 98 by the examiner actually was an element of claim 97. Accordingly it is claim 97 which has been amended to correct this ambiguity.

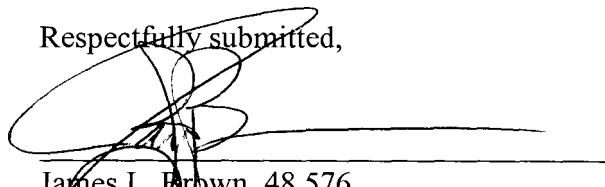
CLAIM REJECTIONS 35 USC § 102

Claims 1-5, 7-10, 15 and 87-98 stand rejected under 35 USC 102(a) as being anticipated by Martin et al. (IDS ref: Adv. Materials (8/19/1999) vol.11, no. 12, pages 1021-1025). On July 23, 2004 applicants submitted a Declaration under 37 CFR 1.132 signed by inventors Michael J Natan, Ph. D. and Thomas Mallouk, Ph. D. The Declaration states that the inventors are aware of the Martin et al. reference and declares that the cited disclosure in the Martin publication was conceived of and invented by the present inventors. The affidavit further states that inventorship of this application is correct and that the reference concerns subject matter derived from the inventors rather than invented by the remaining authors. Applicant notes that Martin is submitted as § 102(a) prior art. Since the affidavit establishes that the Martin reference was published by applicants or on their behalf and that the Martin reference describes applicant’s work, the previously filed affidavit will overcome the 102(a) rejection. The scope and subject matter of the claims pending at the time of the affidavit and the presently pending claims is the same in all material respects.

For the reasons set forth above, Applicant respectfully submits the claims as amended are allowable over the art of record and reconsideration and issuance of a notice of allowance are respectfully requested. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117 if not otherwise specifically requested. The undersigned hereby authorizes the charge of any required fees not included or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,



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